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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,987	10/13/2004	Christopher Michael Penfold	2955-207	2253

6449. 7590 01/25/2008  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER
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GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

NOTIFICATION DATE	DELIVERY MODE
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01/25/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

## Office Action Summary

Application No.

10/510,987

Applicant(s)

PENFOLD ET AL. CT

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,11 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,11 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Newly submitted claims 17 and 18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1-16, drawn to a pack and general method of providing not particular on steps of the method.

Group II, claim(s) 17 and 18, drawn to a particular method of providing the pack incorporating particular method steps.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The new method of manufacturing as claimed is not seen to be an obvious variant of the original claimed pack and any general methodology of providing the pack which in any case was not subject of the application as originally filed. It is not seen that the process as claimed is specially adapted for the manufacture of the product, as the pack could be molded in the non-inverted state, obviating the need for the forcing step and still resulting in the product as claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17 and 18 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-8 and 10-11 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 10, the recitation of "a cover piece" is either double recitation with line 2, or an indefinite employment of the same term for two different structures. It is not clear as to the relationship of one of the cover pieces defined in line 2 to the cover piece subsequently defined in line 10. In line 10, "a cover piece" should be --a said cover piece--.

In claim 8, the claim appears to be redundant in view of amended claim 1 at line 8.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, 6-8, 10-11 and 16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Toren in view of Reid. Toren discloses a pack assembly (Figures 1-4) comprising two packs (one on each side of fold line 5) of medicinal tablets joined together and cover pieces (portions of 4 or surface of 1 receiving the aluminum 4 on either side of 5), the two packs being joined such that the assembly has a stowed configuration (Figure 8) in which the medicinal tablets cannot be expelled and an

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opened configuration (as in Figure 6) in which the medicinal tablets can be expelled, the cover pieces being in face to face relation when the assembly is in its stowed configuration, each pack comprising a base wall (1) which defines a plurality of locations for the tablets, wherein at each location there is a pocket (2) which is integral with the base wall and constitutes a recess for a tablet, a cover piece (portions of 4 or surface of 1 receiving the aluminum 4 on either side of 5) of a rupturable material and a tablet (3) between the pocket and the cover piece, wherein the base wall is of sufficient rigid construction as to be resistant to permanent deformation. Toren does not disclose each pocket to be substantially hemispherically dome-shaped. Reid discloses a similar pack wherein each individual pocket is substantially hemispherically dome-shaped and elastic so as to be reversibly flexed (pushing on the pocket from Figure 4 to return to Figure 3). To modify Toren's somewhat domed pocket with a hemispherically dome-shaped pocket as claimed would entail a mere change in shape of the pocket and yield only predictable results, as described in Reid at column 3, lines 33-40. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. To modify the pockets of Toren to be shaped and flexible in the manner of Reid would have been obvious in order to facilitate removal of the tablets from the pack, as suggested by Reid.

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As to claim 3, each discloses tablets in and of themselves (naked).

As to claim 4, each discloses the tablets provided in a blister pack.

As to claim 6, each discloses at least four pockets.

As to claim 7, Toren discloses the base wall formed from a polymer (see column 3, lines 39-46)

As to claims 10 and 11, Reid further discloses that the pocket can be pushed inwardly causing a stable inverted configuration (see column 1, lines 33-54) bending about a hinge line pre-stressed to invert (see column 2, line 43 through column 3, line 32). To modify the pocket and base wall structure of Toren employing the pre-stressing and stable inverted conversion as taught by Reid would have been obvious in order to facilitate inverting the pocket and removing the tablet, as suggested by Reid.

As to claim 16, Reid further suggests injection molding as a method to form the pack.

6. Applicant's arguments filed November 5, 2007 have been fully considered but they are not persuasive. The pocket dome structure as disclosed by Reid would be inherently returnable to its condition of Figure 3, after being placed in the condition of Figure 4, as there is no disclosure otherwise, and one of ordinary skill in the art would recognize the resiliency of the plastic materials disclosed (see column 2, lines 59-66) and fully expect its capability of returning to the condition of Figure 3 except with the content expelled.

7. Applicant's amendment necessitated the new ground(s) of rejection under 35 USC 112 presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/Bryon P. Gehman/

Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG